

1 Remarks

2 Claim Objections

3 Claims 1-16 were objected to because the compositions of the aluminum  
4 alloys should reflect that the weight percent is used.

5 In response, claims 1-3, 7-9 and 11-13 have been amended to indicate that  
6 the percent of alloy is weight percent. The unamended claims do not recite any  
7 percent of alloy, and so no amendment is necessary.

8 The Applicants believe that the amendments to claims 1-3, 7-9 and 11-13 fully  
9 address the objections to the claims, and therefore request that the objections to the  
10 claims now be removed.

11  
12 Rejections of claims under 35 USC § 102

13 Claims 1-2 and 11-12 have been rejected as being anticipated by Brasse  
14 (U.S. Pat. 3,732,083); claims 1-3 and 11-13 have been rejected as being anticipated  
15 by Slater (U.S. Pat. 3,300,838); claims 1-4, 6, 11-14 and 16 have been rejected as  
16 being anticipated by Lynch (U.S. Pat. 2,539,248); claims 1-4 and 11-14 have been  
17 rejected as being anticipated by Ramos (WO 96/11800); and claims 1-4 and 11-14  
18 have been rejected as being anticipated by Wyatt (U.S. Pat. 2,747,256).

19 Claims 1 and 11 are independent claims. Accordingly, if the Applicants can  
20 demonstrate that claims 1 and 11 are patentable, then those claims which depend  
21 therefrom should also be allowed.

22 It is well established that “[a]nticipation requires that all of the elements and  
23 limitations of the claims are found within a single prior art reference.” (Scripps Clinic  
24 and Research Found. v Genetech. Inc., 927 F.2d 1565, 1576, 18 U.S.P.Q.2d 1001,  
25 1010 (Fed. Cir. 1991 (emphasis added))). Moreover, the PTO and the Federal Circuit  
provide that §102 anticipation requires that there must be no difference between the

1 claimed invention and the reference disclosure. (Scripps Clinic and Research Found.  
2 v. Genetech, Inc., id. (emphasis added)).

3 Accordingly, if the Applicants can demonstrate that any one element or  
4 limitation in claims 1 and 11 is not disclosed by Brasse, Slater, Lynch, Ramos or  
5 Wyatt, then the respective claim(s) must be allowed.

6 Claims 1 and 11 have been amended to include the limitation that “the second  
7 member consisting essentially of Al and between about 1.8 wt.% to 10.0 wt.% Si”.  
8 Support for this amendment is found in the specification at page 4 lines 12-13. This  
9 limitation precludes the addition of other alloys (in any significant amount) to the  
10 second member. As described throughout the specification, this limitation is  
11 particularly useful for transition inserts since it maintains the electrical conductivity  
12 and weldability of the second member, resistance to cracking, and a relatively high  
13 melting point of the second member. However, in each of Brasse, Slater, Lynch,  
14 Ramos and Wyatt, the described aluminum components include other alloys beyond  
15 silicon. Specifically: Brasse at col. 2 lines 50-53 states, “the aluminum based  
16 bearing alloy composition contains, as the essential alloying elements, from about  
17 3.5% to about 4.5% tin ... from about 0.7% to about 4.5% copper ....”; Slater at col. 2  
18 lines 30-32 states, “the aluminum alloy should consist essentially of ... .5 to 4%  
19 cadmium ....”; Lynch at col. 2 lines 14-21 describes that the aluminum used typically  
20 includes “cadmium up to 5%”, or “6.5% tin ... 1% copper [and] 0.5% nickel ....”;  
21 Ramos at page 3 line 28 states that, “the aluminum alloy comprises from 3 to 30% of  
22 tin; and Wyatt at col. 1 lines 48-53 states that, “the [aluminum] alloy may also contain  
23 up to 18% by weight of tin, ... up to 1% of iron, up to 2 ½% of magnesium, up to 2%  
24 of cadmium, up to 2% of lead, and up to 2% of zinc ....” It should be noted that  
25 Brasse, Slater, Lynch, Ramos and Wyatt are all directed towards producing  
compounds for bearing surfaces. The considerations for producing bearing surfaces  
are considerably different than the considerations for producing transition inserts

1 (which are recited at length in Applicants' specification). Specifically, maintaining  
2 electrical conductivity and a relatively high melting point in the aluminum alloy are  
3 not relevant to bearing surfaces, whereas such considerations are relevant to  
4 transition inserts.

5 Accordingly, since claims 1 and 11 (and inherently, those claims which  
6 depend therefrom) now recited a limitation neither taught nor suggested by the cited  
7 references, the references cannot anticipate claims 1-6 and 11-16. The Applicants  
8 therefore request that the rejections of claims 1-4, 6, 11-14 and 16 be removed and  
9 the claims allowed.

10  
11 Rejections of claims under 35 USC § 103

12 Claims 6 and 16 have been rejected as being obvious in light of Ramos (WO  
13 96/11800).

14 Claim 6 depends from claim 1, and claim 16 depends from claim 11. For the  
15 reasons stated above, the Applicants contend that claims 1 and 11 (as amended)  
16 are allowable. As stated in MPEP 2143.03, "If an independent claim is nonobvious  
17 under 35 U.S.C. 103, then any claim depending therefrom is nonobvious." As claims  
18 1 and 11 (as amended) are nonobvious, then claims 6 and 16 (which depend  
19 respectively therefrom) are also nonobvious, and are thus allowable. The Applicants  
20 therefore request that the rejections of claims 6 and 16 be removed and the claims  
21 allowed.

22 Claims 1-16 have been rejected as being obvious over Lynch (U.S. Pat.  
23 2,539,248) in view of Szecket (U.S. Pat. 4,842,182).

24 Claims 1, 7 and 11 are independent claims. Accordingly, if claims 1, 7 and 11  
25 are allowable (i.e., nonobvious), then the claims which depend therefrom are also  
nonobvious and allowable.

1 As set forth in MPEP 2143, "To establish a prima facie case of obviousness,  
2 three basic criteria must be met. First, there must be some suggestion or motivation,  
3 either in the references themselves or in the knowledge generally available to one of  
4 ordinary skill in the art, to modify the reference or to combine reference teachings.  
5 Second, there must be a reasonable expectation of success. Finally, the prior art  
6 reference (or references when combined) must teach or suggest all the claim  
7 limitations. The teaching or suggestion to make the claimed combination and the  
8 reasonable expectation of success must both be found in the prior art, not in  
9 applicant's disclosure." (Emphasis added.)

10 The Applicants contend that claims 1, 7 and 11 are nonobvious over Lynch in  
11 view of Szecket since those claims, as amended, include a limitation not taught or  
12 suggested by the references. Specifically, claims 1, 7 and 11 now include the  
13 limitation that "the second member consisting essentially of Al and between about  
14 1.8 wt.% to 10.0 wt.% Si".

15 As described above, Lynch does not teach or suggest this limitation, as Lynch  
16 describes at col. 2 lines 14-21 that the aluminum used typically includes "cadmium  
17 up to 5%", or "6.5% tin ... 1% copper [and] 0.5% nickel ...." Szecket does not cure  
18 the deficiency of Lynch. Specifically, Szecket only describes a method of bonding  
19 metals and their alloys, including "aluminum ... and their respective alloys" (col. 3  
20 lines 24-29 and the table in Fig. 27). Any combination of Lynch and Szecket only  
21 results in using the aluminum alloy described by Lynch (which contains cadmium, or  
22 tin, copper and nickel) in the process of Szecket. That is, neither reference teaches  
23 or suggests using a second member in a bonded assembly with a first member  
24 wherein "the second member consist[s] essentially of Al and between about 1.8 wt.%  
25 to 10.0 wt.% Si".

For at least this reason the Applicants contend that independent claims 1, 7  
and 11 (as amended), and the claims that depend therefrom, are not obvious over

1 Lynch in view of Szecket. The Applicants therefore request that the rejections of  
2 claims 1-16 under 35 USC 103 be removed and the claims allowed.

3  
4 Request for Extension of time under 37 CFR § 1.136(a)

5 Applicants hereby request a three (3) month extension of time under 37 CFR  
6 § 1.136(a) to respond to the Office action of March 24, 2005, to and through  
7 September 26, 2005. It being noted that September 24, 2005 was a Saturday, under  
8 37 CFR § 1.7, the Applicants are given until Monday, September 26, 2005 to file the  
9 response under the three month extension.

10 The required fee is enclosed herewith.

11  
12 Summary

13 The Applicants believe this is a full and complete response to the Office action  
14 mailed March 24, 2005. The Applicants further believe that claims 1-16 are  
15 allowable, and therefore request timely allowance of those claims.

16 The Examiner is respectfully requested to contact the below-signed attorney if  
17 the Examiner believes this will facilitate prosecution toward allowance of the claims.

18  
19 Respectfully submitted,

20 Steven W. Ping and Rick James

21 Date: September 26, 2005

22 By John S. Reid  
23 John S. Reid  
24 Attorney and agent for Applicant  
25 Reg. No. 36,369  
Phone: (509) 534-5789